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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,054	05/26/2006	Rainer Breitenbach	INA-40	1220
20311 7590 02/24/2010 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
			EXAMINER MACARTHUR, VICTOR L	
			ART UNIT 3679	PAPER NUMBER
			NOTIFICATION DATE 02/24/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

Office Action Summary

Application No.

10/596,054

Applicant(s)

BREITENBACH ET AL.

Examiner

VICTOR MACARTHUR

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Restriction

Claims 1-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 27, 2008.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelsen et al., GB-2,301,548.

Regarding claim 15, as best understood, Nelsen et al. disclose, in Figure 5, a screwed joint comprising a flange **14**, a drive element **10'**, a nut **46**, and a bolt **22**. The bolt **22** is on the drive element **10'**. The drive element **10'** and the flange **14** are screwed together at least by the nut **46** and the bolt **22**. The nut **46** has an undercut **A1** (the groove; see marked-up attachment) at least on a portion of the nut **46** from a direction of the flange **14**. The portion is spaced axially in relation to the flange **14**. The undercut **A1** (the groove; see marked-up attachment provided in the last Office action) has a radial wall **A2** (every groove inherently has a radial wall) facing the flange **14**. The undercut **A1** is open (note that if the undercut **A1** were not open, the undercut would not be a groove). The nut **46** is extended axially by a shank **A3**. As detailed above, the

prior art structure is substantially identical to the claimed structure such that the PTO must presume claimed functions/properties (i.e., functional intended use with a tool, etc.) to be inherent, thus presenting a *prima facie* case and properly shifting the burden to prove otherwise with evidence to the applicant. It is fairly the applicant's burden to obtain and test the prior art since the Patent Office is unable to manufacture or obtain prior art products. Mere allegation that the prior art does not inherently possess applicant's claimed functions/properties is not sufficient without actual evidence proving as much. See the following:

- MPEP §2112.01 (I);
- MPEP §2114;
- *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
- *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);
- *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);
- *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed.Cir. 1990);
- *In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 (Fed.Cir.1997)

Regarding claim 16, the undercut **A1** is at least one radial recess **A1**.

Regarding claim 17, the radial recess **A1** is at least one annular groove **A1**.

Regarding claim 18, the bolt **22** has an external thread. The nut **46** has an internal thread corresponding to the external thread (page 5, 2-4). The annular groove **A1** is on an outer side facing away radially from the internal thread (the groove is on the outside of the internal thread).

Claims 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hetmann et al., 3,635,303.

Regarding claim 15, as best understood, Hetmann et al. disclose, in Figure 2, a screwed joint comprising a flange 67, a drive element 54, a nut 57, and a bolt (threaded portion where nut is threaded). The bolt is on the drive element 54. The drive element 54 and the flange 67 are screwed together at least by the nut 57 and the bolt. The nut 57 has an undercut 58 at least on a portion of the nut 57 from a direction of the flange 67. The portion is spaced axially in relation to the flange 43. The undercut 58 has a radial wall (every groove has two radial walls) facing the flange 67. The undercut 58 is open. The nut 57 is extended axially by a shank A1 (see marked-up attachment provided in the last Office action). As detailed above, the prior art structure is substantially identical to the claimed structure such that the PTO must presume claimed functions/properties (i.e., functional intended use with a tool, etc.) to be inherent, thus presenting a *prima facie* case and properly shifting the burden to prove otherwise with evidence to the applicant. It is fairly the applicant's burden to obtain and test the prior art since the Patent Office is unable to manufacture or obtain prior art products. Mere allegation that the prior art does not inherently possess applicant's claimed functions/properties is not sufficient without actual evidence proving as much. See the following:

- MPEP §2112.01 (I);
- MPEP §2114;
- *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
- *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);
- *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);

- *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed.Cir. 1990);
- *In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 (Fed.Cir.1997)

Regarding claim 16, the undercut **58** is at least one radial recess **58**.

Regarding claim 17, the radial recess **58** is at least one annular groove **58** (col. 4, ll. 6-8).

Regarding claim 18, the bolt has an external thread. The nut **57** has an internal thread corresponding to the external thread. The annular groove **58** is on an outer side facing away radially from the internal thread.

Regarding claim 19, Hetmann et al. disclose, in Figure 2, a screw joint comprising a drive element **55**, a flange **43**, and a nut **57**. The drive element **55** has an integral bolt **54**. The nut **57** is threaded to the bolt **54** connecting the drive element **55** and the flange **43**. The nut **57** has an undercut **58** on a portion of the nut **57** from a direction of the flange **43**. The undercut **58** has a radial wall facing the flange **57**. The nut further has an axially extending shank **A1** (see marked-up attachment provided in the last Office action) that is axially within the flange **43**. The shank **A1** has an internal thread threaded on the bolt **54**.

Claims 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato, 5,651,588.

Regarding claim 15, as best understood, Kato discloses, in Figure 1, a screwed joint comprising a flange **20**, a drive element **24**, a nut **26**, and a bolt **24a**. The bolt **24a** is on the drive element **24**. The drive element **24** and the flange **20** are screwed together at least by the nut **26** and the bolt **24a**. The nut **26** has an undercut **A1** (see marked-up attachment) at least on a

portion of the nut **26** from a direction of the flange **20**. The portion is spaced axially in relation to the flange **20**. The undercut **A1** has a radial wall **A2** (every groove has two radial walls) facing the flange **20**. The undercut **A1** is open. The nut **26** is extended axially by a shank **A3**. As detailed above, the prior art structure is substantially identical to the claimed structure such that the PTO must presume claimed functions/properties (i.e., functional intended use with a tool, etc.) to be inherent, thus presenting a *prima facie* case and properly shifting the burden to prove otherwise with evidence to the applicant. It is fairly the applicant's burden to obtain and test the prior art since the Patent Office is unable to manufacture or obtain prior art products. Mere allegation that the prior art does not inherently possess applicant's claimed functions/properties is not sufficient without actual evidence proving as much. See the following:

- MPEP §2112.01 (I);
- MPEP §2114;
- *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
- *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);
- *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);
- *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed.Cir. 1990);
- *In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 (Fed.Cir.1997)

Regarding claim 16, the undercut **A1** is at least one radial recess **A1**.

Regarding claim 17, the radial recess **A1** is at least one annular groove **A1**.

Regarding claim 18, the bolt **24a** has an external thread (it is known that bolts inherently have an external thread to connect to the nut). The nut **26** has an internal thread corresponding to the external thread. The annular groove **A1** is on an outer side facing away radially from the internal thread.

Regarding claim 19, Kato discloses, in Figure 1, a screw joint comprising a drive element **24**, a flange **20**, and a nut **26**. The drive element **24** has an integral bolt **24a**. The nut **26** is threaded to the bolt **24a** connecting the drive element **24** and the flange **20**. The nut **26** has an undercut **A1** (see marked-up attachment) on a portion of the nut **26** from a direction of the flange **20**. The undercut **A1** has a radial wall **A2** facing the flange **20**. The nut **26** further has an axially extending shank **A3** that is axially within the flange **20**. The shank **24a** has an internal thread threaded on the bolt **24a** (note that nuts are known to have an internal thread to connect to a bolt that inherently has a thread).

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Applicant argues that the prior art fails to expressly disclose the limitation "to be engageable axially from behind by clamping elements of an assembly tool" (claim 15). This is not persuasive. Clearly, applicant does not seek narrow protection of an assembly tool. Rather applicant seeks to prevent others from making/selling applicant's screwed joint regardless of whether or not others make/sell the assembly tool in positive structural combination therewith

(i.e., the joint is not structurally limited by a tool but is merely intended for functional use therewith). Accordingly, the following guidelines apply:

- MPEP §2112.01 (I) states “When the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent... [and] a *prima facie* case of either anticipation or obviousness has been established” (emphasis added);
- MPEP §2114 states “Apparatus claims must be structurally distinguishable from the prior art... [and the] Manner of operating the device does not differentiate apparatus claim from the prior art... [and a] claim containing a ‘recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus’ if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)” (emphasis in original).
- “Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludke*, *supra*. Whether the rejection is based on ‘Inherency’ under 35 USC 102, on ‘*prima facie* obviousness’ under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. See *In re Brown*, 59 CCPA 1036, 459 F.2d

531, 173 USPQ 685 (1972)" (emphasis added) *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);

- "Apparatus must be distinguished from the prior art in terms of structure rather than function." *In re Schreiber*, 128 F.3d 1473, 1477-78 44 USPQ2d 1429, 1431-32 (Fed.Cir.1997)
- "Apparatus claims cover what a device is, not what a device does." See *Hewlett-Packard Co. v. Bausch & Long Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)
- "[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." (emphasis added) *In re Swinehart*, 58 CCPA --, --F.2d --, 169 USPQ 226 (1971), and *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
- "[I]t is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair

and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." (emphasis added) *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);

- "Contrary to appellant's reasoning, after the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to appellant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on... Here, appellant's burden before the board was to prove that Donley's structure does not perform the so-called method defined in the claims when placed in ambient light. Appellant did not satisfy that burden, it did not suffice merely to assert that Donley does not inherently achieve enhanced color through interference effects, challenging the PTO to prove the contrary by experiment or otherwise. The PTO is not equipped to perform such tasks." *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- "Spada was reasonably required to show that his polymer compositions are different from those described by Smith. This burden was not met by simply including the assertedly different properties in the claims. When the claimed compositions are not novel they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in the prior art." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

- MPEP §716.01(c)(II) states “The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).”

Applicant remaining arguments similarly allege that the prior art structure reading on applicant's claimed structure is not capable of functioning as claimed by applicant. As detailed in MPEP 2112.01, 2114, and the case law noted above, when the prior art anticipates or makes obvious applicant's claimed structure, the burden lies with applicant (not the Office) to obtain and test the prior art, and submit actual evidence proving the prior art incapable of performing the claimed functions. This burden is fairly the applicant's since it is the applicant, not the Office, that is endeavored in the making of screwed joints. If applicant unable or unwilling to submit such evidence of non-functionality, then the examiner strongly suggests amending the claims to obtain patentability based upon on structural limitations, rather than mere functional intended use.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

February 23, 2010

/Victor MacArthur/
Primary Examiner, Art Unit 3679